

REMARKS

This is in response to the Office Action mailed January 14, 2000. Claim 1, 6, 14, 17, 18, 19, 21, 23, and 32 have been amended to more particularly point out and distinctly claim what applicants regard as the invention, claims 11 and 16 have been canceled without prejudice, and claim 44 has been added. Specifically, claims 1 and 6 have been amended to clarify that document or message is automatically deleted upon the occurrence of a predetermined condition. Claim 1 has also been amended to replace the alternative phrase "overwrite and/or delete" with "delete". Claims 6, 14, 17, 18, and 19 have been amended, and claim 44 added, to conform to the changes in claims 1 and 6. Claims 21, 23, and 32 have been amended to remove certain typographical errors.

1. The Examiner' Rejection of Claims 1-19

Claims 1-19 were rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 5,876,281 to Nozoe et al. (the Nozoe patent) in view of Patent No. 5,848,419 to Hapner et al. (the Hapner patent).

In support of his rejection, the Examiner notes:

As per claim 1, Nozoe et al disclose creating an executable module or object or code or macro or email message or information attacher [col 2 line 34] which instructs a computer to overwrite and/or delete or update [col 8 line 51] a document to which the executable module is attached; attaching the executable module to the document. However, Nozoe et al did not teach the self-destructing module or executable module attaching to e-mail message or document. The skilled artisan would have looked into the network communication art and have been led to utilize the method creating a self-destroy object as taught by Hapner et al [Hapner col. 14, lines 25, 34, 40, 52]. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the self destroy object or module or macro as taught by Hapner et al into the email attachment of Nozoe et al in order to enhance the data management and control on network. . . . [Claim 6 contains] similar limitations set forth of [sic] method [claim 1].

Claims 1 and 6 recite:

1. A method for creating a self-destructing document, comprising the steps of:
creating an executable module which instructs a computer to automatically delete a document to which the executable module is attached when a predetermined condition is met;
attaching the executable module to the document.
6. A self-destructing e-mail messaging system, comprising:
an executable module, the executable module configured to instruct a computer to automatically delete a message to which the executable module is attached when a predetermined condition is met;
an e-mail messaging system, the e-mail messaging system configured to create an e-mail message and to transmit the e-mail message, the e-mail messaging system attaching the executable module to the e-mail message prior to transmission.

It is respectfully submitted that the Nozoe patent does not disclose or suggest creating an executable module that automatically deletes a document or e-mail message, or attaching such a module to a document or e-mail message as recited in claims 1 and 6 respectively.

The Nozoe patent purports to disclose an e-mail messaging system which allows a sender to specify a sequence of functions to be performed by a recipient of the e-mail message. The requested processes are represented by icons, or buttons, in a graphical user interface window displaying the e-mail message on a computer display. (Fig. 14) The sender can specify the location of the icons in the e-mail message and can dictate a sequence of icons to be displayed to the recipient in the e-mail message. The processes (and their associated icons) may include a replying process for replying to the e-mail (element 1002 in Fig. 14); an RSVP process to answer an e-mail invitation so the recipient can indicate whether they will be attending an event (Fig. 14), or a request for the recipient to delete the message (Col. 6, lines 3-4).

It should be noted, however, that the Nozoe patent requires the recipient to actively delete the e-mail by clicking on an icon, and provides no disclosure or suggestion of automatically overwriting and/or deleting the e-mail message or any attachment thereto, upon the occurrence of a predetermined condition as recited in independent claims 1 and 6.

In addition, as clearly indicated in the following passages, the executable programs or scripts for performing the specified functions are not attached to the e-mail message. As noted in col. 2, lines 15-21, the Nozoe patent attaches “to the data of the electronic mail, icon sequence information for defining the sequence of the icons specified by the processing flow definer and correspondence information in which positional information for specifying the positions in the message of the icons displayed by the first display is related to the function names corresponding to the icons.” See also Col. 12, lines 32-51 (describing the attached data in further detail).

The executable program or scripts which execute the functions are contained in the function table 530 of the control table of Figure 5. Specifically, in col. 7, lines 20- 40, the Nozoe patent notes that:

Reference numeral 520 indicates the control table for holding information associated with the function buttons and has an area 521 for storing a button ID, an identifier of the function button; an area 522 for storing a button name to be displayed on the function button; an area 523 for storing a function ID, an identifier of the processing to be performed; an area 524 for storing a pointer to data for storing shape data of the function button; an area 525 for storing a pointer to a previous control table; and an area 526 for storing a pointer to a next control table, namely a control table 540. The above-mentioned function ID is registered beforehand in the function table 530, related to the processing to be executed in an electronic mail send-receive operation. The function table 530 has an area 531 for storing the function ID, an area 532 for storing a function name of the processing, an area 533 for storing outline information about the function of the processing (to be displayed in a function button list window of FIG. 8 for confirming the information about the registered function buttons, and an area 534 for storing a script written with commands for instructing processing execution.

The function table 530, along with the remaining data structure of the control table illustrated in Figure 5, is stored externally from the individual e-mail messages, and is accessible by all users of the e-mail system. As explained on col. 7, lines 5-14:

FIG. 5 shows an example of a data structure of the control table for entering functions of the function button of FIG. 4. For the information processing units constituting the system associated with the present invention to be able to reference a common table, the control table of FIG. 5 is shared by the information processing units or control tables having equal contents are provided for respective information processing units. For implementation, a file server may be provided on the network or the control table may be distributed to each of the information processing units.

In view of the above, the Nozoe patent also fails, at the very least, to disclose or suggest, an executable module that automatically overwrites and/or deletes a document which executable module is attached to the e-mail message or document.

With regard to the specific portions of the Nozoe patent which are referenced by the Examiner in his rejection:

Column 2, line 34 of Nozoe contains a discussion of the "correspondence information" which is attached "by the attacher" to the e-mail when the e-mail is created. As explained on lines 34-36, however, this correspondence information is used to obtain positioning information for icons that represent the requested processes to be displayed in the e-mail.

Column 8, line 51 refers to the control table that is entered into a linked list "to update the number of registered function buttons 511 held in the header 510 of the list." However, the process described in the cited portion of the specification relates to a procedure for the creator of the message to update the control table prior to sending an e-mail message. It does not suggest that the e-mail message or document, once sent, is updated or effected in any way. Moreover, as discussed above, the control table is not attached to an e-mail message or document.

It is therefore respectfully submitted that the Nozoe patent does not discuss or suggest automatically deleting a e-mail message or document when a predetermined condition is met, and certainly provides no suggestion or motivation to create an executable module which automatically deletes a document or e-mail when a predetermined condition is met, and to attach such a module to the document as recited in independent claims 1 and 6.

The Hapner patent cannot cure the above-referenced deficiencies in the Nozoe patent. The Hapner patent purports to disclose an object with a self-destruct function for non-activity,

replacement or an orderly shutdown. There is no suggestion in the Hapner patent that such a “self destroy” object could, or should, be attached to an e-mail or document. Similarly, there is no suggestion in the Nozoe patent to attach an executable module to the e-mail message in order to perform the processing functions discussed therein. Moreover, neither the Hapner patent or the Nozoe patent contain any discussion of document retention or security issues, or create any motivation to use an executable module, which is attached to a document or e-mail message, to delete the document or e-mail message.

For the foregoing reasons, it is respectfully submitted that the Examiner’s rejection of claims 1 and 6 is overcome and should be withdrawn. As claims 2-5, and 7-19 depend from and incorporate the limitations of claims 1 and 6 respectively, withdrawal of the Examiner’s rejection of these claims is also requested.

With regard to claim 10, it is respectfully submitted that the combination of the Nozoe patent and the Hapner patent also fail to disclose or suggest overwriting “the message with null characters” as claimed. In support of his rejection, the Examiner asserts that overwriting the message with null characters is an inherent feature of the “self destroy object” of the Hapner patent. It is respectfully submitted, however, that there is no mention or suggestion in the Hapner patent of overwriting anything with null characters. Moreover, it is not inherent that the process of deleting a file or program includes overwriting the file or program with null characters. To the contrary, in general, “[f]iles that you delete aren’t actually deleted at all. The computer just changes the first letter of the file name.” G.Covlin, Shredder, Fortune Business Report (July 17, 1998)(of record). On this basis as well, withdrawal of the Examiner’s rejection of claim 10¹ is respectfully requested.

Applicants also wish to note that claims 18 and 19 recite that the document (claim 18) or message (claim 19) is encrypted, and that the executable module is configured to instruct the

¹ Applicants note that the same reasoning also applies to new claim 44.

computer to decrypt the document or message if the predetermined condition is met, and to delete the document or message if the predetermined condition is not met. Neither the Nozoe patent or the Hapner patent contain any discussion or suggestion of encryption, much less a discussion or suggestion of the specific steps recited in claims 18 and 19. On this basis as well, withdrawal of the Examiner's rejection of claims 18 and 19 is respectfully requested.

2. The Examiner's Rejection of Claims 20 and 24-31

Claims 20 and 24-31 are rejected under 35 U.S.C. §103 as being unpatentable over the Nozoe patent in view of the Hapner patent and further in view of U.S. Patent No. 5,689,699 to Howell et al (the Howell patent).

Claim 20 recites:

A method for creating a virtual container containing a digital object, comprising the steps of

- creating a virtual container, the virtual container residing in contiguous locations in an electronic storage media of a computer, the virtual container including a header portion and a digital object portion;

- selecting a digital object for insertion into the virtual container;

- applying an encryption technique to the digital object to create an encrypted digital object;

- writing the encrypted digital object into the digital object portion;

- selecting an expiration date for the digital object;

- writing information indicative of the expiration date into the header portion of the virtual container.

In support of his rejection, the Examiner asserts that "Nozoe-Hapner discloses creating a virtual container or e-mail attachment object, the virtual container residing in contiguous locations in an electronic storage media of a computer [Hapner col. 11, line 43], the virtual container including a header portion and a digital object portion [Nozoe Fig. 4, col 8, line 52]; selecting a digital object for insertion into the virtual container [Hapner col. 7, lines 45-47]."

The Examiner concedes that Nozoe-Hapner fails to “teach applying an encryption technique to the digital object to create an encrypted digital object; writing the encrypted digital object into the digital object portion; selecting an expiration date for the digital object ; writing information indicative of the expiration date into the header portion of the virtual container”, but asserts that the skilled artisan “would have looked to the e-mail processing art and have been led to the technique delete the object when the expiration time or date has occurred as taught by Howell et al [col. 2, lines 1-9].” On this basis, the Examiner asserts that “it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the Howell technique which deletes the expiration object in to the Nozoe-Hapner system in order to enhance the network management system.”

As set forth above, the Nozoe patent purports to disclose an e-mail messaging system which allows a sender to specify a sequence of functions to be performed by a recipient of the e-mail message. Applicant assumes that the Examiner is asserting that an e-mail message having an e-mail attachment according to the Nozoe patent corresponds to the claimed virtual container. The Nozoe patent, however, contains no discussion of providing an expiration date for the e-mail or its attachments, and provides no mechanism for deleting an expired e-mail or attachment. The Nozoe patent also fails to disclose or suggest encrypting the e-mail or its attachments. In fact, the Nozoe patent contains no discussion of document retention or document security issues at all. With regard to the portions of the Nozoe patent which the Examiner asserts show “the virtual container including a header portion and a digital object portion [Nozoe Fig. 4, col 8, line 52]”:

Figure 4 merely shows an e-mail message as it would appear on a monitor of a computer system according to the Nozoe patent. There is no mention of any “header” or digital object.

Col. 7, line 52 of the Nozoe patent discusses updating the header of the control table of Figure 5 to reference the number of buttons in the control table. As discussed above, the control table includes identification information for the “buttons” which are available to a

user of the e-mail system for creating e-mail messages, and does not form part of the e-mail messages themselves. There is no indication that the control table resides in contiguous memory locations. Moreover, as the control table of Figure 5 does not form part of the e-mail messages of the e-mail system of the Nozoe patent, there is no reason to assume that the data structures of Figure 5 reside in contiguous memory locations. It is respectfully submitted that the referenced portion of the Nozoe patent cannot support the Examiner's assertion that the patent discloses a virtual container including a header portion and a digital object portion.

The Hapner patent relates to "providing transparent persistence in a distributed object environment" by "replacing the value in the objects data pointer (addressing information which points to the objects limited persistent memory) with a pointer value which points to another persistent storage device." The Hapner patent contains no discussion of creating a virtual container for holding digital objects, no discussion of setting expiration dates for digital objects, and no discussion of encrypting digital objects. Like the Nozoe patent, the Hapner patent contains no discussion of document retention or document security issues at all. With respect to the specific portions of the Hapner patent referenced by the Examiner:

Column 11, line 43 of the Hapner patent merely describes a typical computer architecture: "In addition, a mass storage device 38, such as a hard disk, CD-ROM, magneto-optical (floptical) drive, tape drive or the like, is coupled bidirectionally with CPU 32." No mention is made of how information or processes are stored on the mass storage devices or how information is accessed. There is no mention of memory locations, much less how they are divided and what type of information they contain.

Column 7, line 45-47 of the Hapner patent discusses creating a replica of a persistent data object and replacing an initial data pointer to a data object with a pointer to the persistent data object. The cited reference is concerned with the compiling step of the computer programming process. There is no discussion of creating a virtual container for storing a

digital object, no discussion of a virtual container residing in contiguous memory locations on computer memory, and no discussion of selecting a digital object for insertion into the virtual container.

The Howell patent relates to a “retention management” scheme in which a computer polls each folder and file on a computer, determines the expiration date of the folder or file, and then deletes the file or folder if the current date is later than the expiration date. In this regard, the Howell patent is similar to the prior art systems described in the specification of the present application at page 2, lines 6-19. The Examiner asserts that a skilled artisan would “have looked to the e-mail processing art and have been led . . . to Howell”. However, the Howell patent contains no discussion whatsoever of e-mail or e-mail processing. The Howell patent, as conceded by the Examiner, also contains no discussion of creating a virtual container which resides in contiguous locations on an electronic storage media of a computer, which digital container includes a header portion and a digital object portion, or selecting a digital object for insertion into the virtual container. Moreover, the Howell patent, like the Nozoe patent and the Hapner patent, contains no discussion of encrypting digital objects, and therefore also fails to suggest encrypting a digital object and inserting encrypted digital object into the virtual container (which it also fails to disclose). Although the Howell patent does purport to disclose selecting an expiration date for files and folders, it does not disclose or suggest “writing information indicative of the expiration date into the header portion of the virtual container” as recited in claim 20. To the contrary, the Howell patent, like the prior art document retention systems described on page 2 of the present application, relies on a polling system which systematically checks the expiration date of each file or folder on the computer in order to enforce a document retention policy. There is no suggestion to create the claimed virtual container, and no suggestion to put expiration date information into a header portion of a virtual container as claimed.

Moreover, the Howell patent provides no motivation or suggestion to modify the e-mail messaging system of the Nozoe patent to provide expiration date information in a header portion of a virtual container. Assuming arguendo, that the combination of the Nozoe patent and the Hapner patent provide the claimed “virtual container having a header portion and a digital object portion, which resides in contiguous locations on an electronic storage media”, and that a motivation exists for combining the Nozoe patent, the Hapner patent, and the Howell patent, the resulting combination would not result in the invention of claim 20. To the contrary, if one of ordinary skill in the art at the time of the invention were to combine the Howell patent with the alleged combination of the Nozoe and Hapner patents, the result would be an e-mail messaging system in which the e-mail server (or file server) polled each e-mail message on the server for its expiration date, and deleted any expired messages or attachments. On this basis, withdrawal of the Examiner’s rejection of claim 20 is respectfully requested.

Moreover, as neither the Howell patent, the Nozoe patent or the Hapner patent contains any discussion of encrypting digital objects, it is clear that the combination of the Nozoe, Hapner, and Howell patents cannot provide the claimed steps of encrypting the digital object and inserting encrypted digital object into the virtual container. Withdrawal of the Examiner’s rejection of claim 20 is therefore requested on this basis as well.

As claims 24-31, and 34 depend from and incorporate the limitations of claim 20, withdrawal of the Examiner’s rejection of these claims is also requested.²

² Applicants note that the Examiner rejects claim 24 based upon Col. 8, line 52 and Figure 4 of the Nozoe patent. In view of the discussion of these portions of the Nozoe patent with regard to claim 20, it is respectfully submitted that the Examiner’s rejection of claim 24 is similarly overcome.

2. The Examiner's Rejection of Claims 21-23, 32-33, 35-43

Claims 21-23, and 32-43 stand rejected as obvious over the combination of the Nozoe, Hapner³ and Howell patents, in further view of United States Patent No. 5,586,036 to Pintsov (the Pintsov patent).

A. Claims 21-23, 35-38, 40-42

Claim 21 recites:

21. A method for extracting a document from a virtual container, comprising the steps of :
 reading information indicative of an expiration date from a header portion of a virtual container, the virtual container residing in contiguous locations in an electronic storage media of a computer, the virtual container including the header portion and a digital object portion, the digital object portion containing an encrypted digital object;
 determining, based upon said information, if the electronic object is expired;
 overwriting the digital object portion of the virtual container with null data if the electronic object is expired; and
 reading the digital object from the digital object portion and applying a decryption technique to the digital object if the digital object is not expired.

In support of his rejection of claim 21, the Examiner asserts that:

As per claim 21, Nozoe-Hapner-Howell disclose the steps of reading information indicative of an expiration date from a header portion of a virtual container or email attachment object, the virtual container residing in contiguous locations in an electronic storage media of a computer [Hapner col 11 line 43], the virtual container including the header portion and a digital object portion [Nozoe Fig 11], the digital object portion containing an encrypted digital object;
 determining, based upon said information, if the electronic object is expired [Howell col 2 line 1-9];

³ Although the Examiner refers to "Hasner et al", it is clear that the patent being referred to is United States Patent No. 5,848,419 to Hapner et al. See Office Action at page 6, line 2.

overwriting or update the digital object portion of the virtual container with null data if the electronic object is expired [Nozoe Fig. 12].

However Nozoe-Hapner-Howell did not teach an encrypted digital object and reading the digital object from the digital object portion and applying a decryption technique to the digital object if the digital object is not expired. The skilled artisan would have looked into the communication system art and have been led to utilize the Pintsov technique which teaches an encrypt data [Pintsov col 2 line 55] and if not expired, decryption occurs to obtain the data [Pintsov col 11 line 60]. Therefore, it would have been obvious . . . to incorporate the Pintsov technique of encrypt the data and decrypt data if not expired into the Nozoe-Hapner-Howell in order to enhance the communication process on network [sic]. By this rationale, claim 21 is rejected.

In this regard, the Examiner has essentially applied the combination of the Nozoe, Hapner, and Howell patents in the same manner as applied to claim 20, with the following exceptions:

First, the Examiner now relies on Figure 11 of the Nozoe patent (rather than Figure 4, and Col.8, line 52) to support his contention that the Nozoe patent discloses the claimed digital object having a header portion and a digital object portion, the digital object portion containing an encrypted digital object. Figure 11, however, illustrates a linked list of process flow information for buttons to be displayed in the e-mail message of the Nozoe patent. This data is not encrypted as claimed. Moreover, as this data relates to positioning information and function identification information to be displayed to the recipient of the e-mail, there can be no suggestion that this data is “a digital object” for which an expiration data would, or should, be set as claimed.

Second, the Examiner relies on Figure 12 of the Nozoe patent to support his contention that the Nozoe patent discloses “overwriting or update [sic] the digital object portion of the virtual container with null data if the electronic object is expired”. Applicants assume that the Examiner is referring to steps 1203, 1204, and 1205 of Figure 12 in which “cell information” is

updated. Initially, applicants note that these steps refer to updating a cell with additional valid data. There is no disclosure or suggestion of overwriting any memory location with null data. In addition, the data is updated at the specific request of the creator of the e-mail message during the process of creating the e-mail message. There is no disclosure or suggestion to overwrite any data based on an expiration date.

For these reasons, as well as the reasons set forth above with regard to claim 20, it is respectfully submitted that the combination of the Nozoe, Hapner, and Howell patents fails, at the very least to disclose the claimed steps of “reading information indicative of an expiration date from a header portion of a virtual container . . . , the virtual container including a header portion and a digital object portion, the digital object portion containing an encrypted digital object”; “determining, based upon said information, if the digital object is expired”; “overwriting the digital object portion of the virtual container with null data if the digital object is not expired”; and “reading the digital object from the digital object portion and applying a decryption technique to the digital object if the digital object is expired”.

As the Examiner relies on the Pintsov patent for its purported disclosure of “reading the digital object from the digital object portion and applying a decryption technique to the digital object if the digital object is expired”, the Pintsov patent cannot cure the deficiencies identified above with regard to the Nozoe, Hapner, and Howell patents, and the Examiner’s rejection of claim 21 is overcome and should be withdrawn.

In any event, for the reasons set forth below, the Pintsov patent fails to provide the teaching attributed to it by the Examiner.

The Pintsov patent relates to a postage payment system for postal mail that prints encrypted data about a piece of mail (such as sender address, recipient address, date and subscriber information for the subscribers of the postage payment system) on the piece of mail. When mail with the printed information goes through a scanner for reading the imprinted

information, the information is read and if the *subscription* hasn't expired, *the information about the piece of mail* is decrypted for processing by the system. Moreover, in accordance with the Pintsov patent, the encrypted information is printed on the piece of mail – there is no suggestion to encrypt a digital object and store the encrypted object in a virtual container, or to read encrypted data from a virtual container.

In accordance with claim 21, an expiration date for a digital object in a virtual container is placed in a header portion of the virtual container, so that after the expiration date, the digital object is no longer valid, and cannot be accessed.

In contrast, the Pintsov patent checks whether a subscription to a system is expired. If the subscription is expired, the mail is simply rejected so it cannot be processed by the system. The contents of the mail, or its data, are unaffected and still accessible. If the subscription is not expired and still valid, decryption of the imprinted information occurs to obtain data about the mail, not to obtain its contents. To draw an analogy, the virtual container of claim 21 is like the physical envelope of the Pintsov patent in that both contain information. The present invention encrypts that information and decrypts the information only if it hasn't expired. The Pintsov patent encrypts *data* about the contents of an envelope and decrypts that data only when a subscription is still valid. The validity of the contents of the envelope, the information, is never considered and never effected in the system of the Pintsov patent.

Moreover, the Pintsov patent determines whether the encrypted data is expired by retrieving the “mailers public key . . . from the public key database” and checking “the expiration date of the public key . . . against the data on the imprinted mail.” Col. 9, lines3-5, Col. 11, lines 53-56. Therefore, in the system of the Pintsov patent, the expiration date is obtained from a database external to the envelope. The Pintsov patent does not disclose or suggest obtaining an expiration date from the envelope, and certainly does not disclose or suggest obtaining the expiration date from a virtual container (which it also fails to disclose).

Therefore, contrary to the Examiner's contention, the Pintsov patent fails to disclose the claimed step of "reading the digital object from the digital object portion and applying a decryption technique to the digital object if the digital object is expired". For this reason as well, the Pintsov patent cannot cure the deficiencies in the Nozoe, Hapner, and Howell patents, and the Examiner's rejection should be withdrawn.

Finally, even assuming arguendo, that the Nozoe, Hapner, Howell, and Pintsov patents disclose each and every limitation of claim 21 (which they do not), none of these references contain any suggestion or motivation to combine these references in the manner suggested by the Examiner. The Nozoe patent relates to an e-mail messaging system which purportedly allows a sender to specify a sequence of functions to be performed by a recipient of the e-mail message. It contains no discussion of document retention or security issues. The Howell patent purports to describe a polling based document retention system for files and folders on a computer, and contains no discussion of e-mail messaging or of the need to encrypt or otherwise secure the contents of the files. The Hapner patent relates to "providing transparent persistence in a distributed object environment." It contains no discussion of e-mail messaging, document retention issues, or document security issues. The Pintsov patent relates to a postage payment system for postal mail that prints encrypted data about a piece of mail on the piece of mail. It is respectfully submitted that a person of ordinary skill in the art at the time of the invention would not be motivated to combine these diverse and unrelated technologies.

Withdrawal of the Examiner's rejection of claim 21 is therefore respectfully requested. As the Examiner has rejected claims 22 and 23 "for the same rationale" as claim 21, withdrawal of the Examiner's rejection of these claims is also respectfully requested. As claims 35-38, and 40-42 depend from and incorporate the limitation of one of claims 21-23, withdrawal of the Examiner's rejection of these claims is also respectfully requested.

With regard to claim 35, the Examiner cites the following passage of the Hapner patent in support of his contention that locating each digital object adjacent to its respective digital object header in the virtual container is “a design choice”:

As will be familiar to those skilled in the art of object oriented programming (OAP), an object may be described by two components: executable code and state. Hapner patent, Col. 2, lines 35-36.

It is respectfully submitted that the cited portion of the Hapner patent contains no reference to headers or virtual containers, and provides no teaching of how a digital object might be arranged in a virtual container. Withdrawal of the Examiner’s rejection of claim 35 is therefore requested on this basis as well.⁴

With regard to claims 36-38, 40-42, the Examiner asserts that “Nozoe-Hasner (sic)-Howell-Pintsov” taught the digital object is a document [Howell Col. 1, line 29]/program [Hapner col. 1, line 55].” However, as set forth above, the Examiner’s combination of Nozoe-Hapner-Howell-Pintsov relies upon Figure 11 of the Nozoe patent to support his contention that the Nozoe patent discloses the claimed digital object having a header portion and a digital object portion. Figure 11, however, illustrates a linked list of process flow information for buttons to be displayed in the e-mail message of the Nozoe patent. This process flow information (which consists of a pointer (1124), a sender address (1123), a cell number (1122), and a button id number (1121)) is neither a document or a program. There is no suggestion that programs or documents can be inserted in place of this process flow information. Withdrawal of the Examiner’s rejection of claims 36-43 is therefore requested on this basis as well.

⁴ Claim 34, which depends from claims 27 and 24, contains a similar limitation to claim 35. Although the Examiner has provided no explanation of his rejection of claim 34, it is respectfully submitted that applicants arguments with regard to claim 35 apply equally to claim 34.

B. Claims 32-33, 39 and 43

Although the Examiner references claim 32 (and claims 33, 39 and 43 which depend therefrom) in the Office Action on page 6, line 1, the Examiner has provided no discussion of the basis of his rejection. Claim 32 is an independent claim which recites the steps of creating a virtual container (similar to claim 20), and then transmitting the virtual container to a recipient along with “a container opener utility” for extracting the encrypted digital objects in the virtual container. In this regard, applicants note that the container opener utility performs steps similar to the method for extracting of claim 21.

Therefore, for the reasons set forth above with regard to claims 20 and 21, it is respectfully submitted that the claim 32 is unobvious over the combination of the Nozoe, Hapner, Howell, and Pintsov patents. Moreover, as claims 39 and 43 contain similar limitations to claims 36-38, 40-42, it is respectfully submitted that the arguments set forth above for claims 36-38, 40-42 apply equally to claims 39 and 43.

In addition, applicants respectfully submit that the Nozoe, Hapner, Howell, and Pintsov patents, alone or in combination, fail to disclose or suggest transmitting a virtual container, along with a container opener utility, to a recipient as recited in claim 32. Applicant also wishes to note the Office Action provides no discussion of these limitations of claim 32, and no indication of how these limitations are found in the references applied by the Examiner.

In view of the above, applicants respectfully submit that the Examiner’s rejection of claims 32, 33, 39, and 43 is overcome and should be withdrawn.

The present invention is new, useful, and unobvious. Reconsideration and allowance of the present application is therefore respectfully requested.

Respectfully submitted,
DAVIDSON, DAVIDSON & KAPPEL, LLC

By: _____

Cary S. Kappel
Reg. No. 36,561

Davidson, Davidson & Kappel, LLC
1140 Avenue of the Americas, 15th Floor
New York, New York 10036
(212) 997-1028